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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/636,172

08/07/2003

Takahisa Fujita

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09/07/2004

CHAPMAN AND CUTLER
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EXAMINER

HASAN, MOHAMMED A

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/636,172

Applicant(s)

FUJITA ET AL.

Examiner

Mohammed Hasan

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 4 is/are rejected.
- 7) ☒ Claim(s) 2, 5 - 9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/7/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/22/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Receipt of acknowledged of papers submitted under 35 U.S.C. 119 (a) – (d), which papers have placed of record in the file.

Oath/Declaration

2. Oath and declaration filed on 6/4/2004 is accepted

Information Disclosure Statement

3. The prior art documents submitted by applicant in the Information Disclosure Statement filed on 9/22/2003 have all been considered and made of record (note the attached copy of form PTO – 1449).

Specification

4. The abstract of the disclosure is objected to because “Abstract” should be one paragraph and less than 150 words. Correction is required. See MPEP § 608.01(b).

Claim Objections

5. Claims 5 – 9 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only, and / or cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 5 – 9 have not been further treated on the merits.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, and 4 are rejected under 35 U.S.C. 102 (e) as being anticipated by Kim et al (6,570,698 B2).

Regarding claim 1, Kim et al discloses (refer to figure 1) the method for stabilizing point and optical output of external optical modulator including light source, external optical modulator (11) modulating the light from the light source, optical detector (14) detecting the output light from the external optical modulator and the means of regulating direct current bias (i.e., feed back circuit 15) applied to the external

optical modulator, which regulates the direct current bias determining the operation point of modulation curve of the external optical modulator according to the output of the optical detector (14) wherein , low-frequency signal which is frequency below the lower limit of the signal frequency band of input signal inputted to the external optical modulator is superimposed onto the direct current bias, and the low – frequency component included in the output of the optical detector is extracted , and the output of the low-frequency component is normalized on the basis of the low-frequency signal, and the output-light of light is controlled in accordance with the normalized low-frequency component (column 1, lines 43 – 67, column 2, lines 1- 46).

Regarding claim 3, Kim et al discloses, wherein in control of output light of the light source (33), the output-light of light source is controlled in order that the primary value of the normalized low-frequency component may accord with the subsequent value (column 6, lines 37 – 49).

Regarding claim 4, Kim et al discloses, the device for stabilizing operation point and output of external optical modulator (11) which utilizes the method for stabilizing operation point and optical output of external optical modulator (column 2, lines 14 26).

Allowable Subject Matter

7. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to show the standard value of primary optical output is modified according to ratio of the primary value of the normalized low-frequency component to the subsequent value and optical output is operated on the basis of the modified standard value.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The closest prior art

Yang et al (6,317,247 B1) discloses a bias voltage stabilizing method for electricity-optical modulator based on off-level sampling.

Ishikawa et al (5,917,637) discloses a method of and device for driving optical modulator and optical communication system.

Conclusion

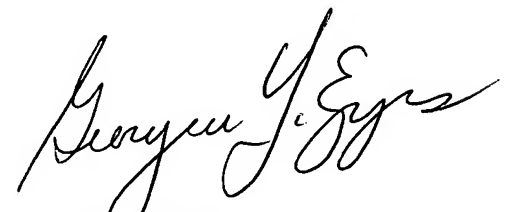
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammed Hasan whose telephone number is (571) 272-2331. The examiner can normally be reached on M-TH, 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on (571) 272- 2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2873

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MH
August 26, 2004



Georgia Epps
Supervisory Patent Examiner
Technology Center 2800